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09/800,477	03/08/2001	Thomas Dodt	P20466	4933

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EXAMINER

JOHNSTONE, ADRIENNE C

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1733

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/800,477
Filing Date: March 08, 2001
Appellant(s): DODT ET AL.

Neil Greenblum
For Appellant

EXAMINER'S ANSWER

MAILED
APR 12 2005
GROUP 1700

This is in response to the appeal brief filed June 17, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is substantially correct. The one inconsistency is the description of the perforated foil on p.7 of the brief: paragraph 0061 of the specification recites that the perforated foil in particular *consists of* synthetic material, but the corresponding paragraph in the summary of the invention merely recites that the perforated foil in particular *includes* a synthetic material.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3 and 6-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

0 663 306 A2

Europe (Dodt et al.)

7-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 0 663 306 A2.

See the translation p. 9 line 1 - p. 11 line 10, embodiment of Figure 2: wheel rim 1 and tire 4 enclosing a tire interior, perforated rubber bicycle tube or tire inner tube 5 (perforated foil) filled with sound-absorbing material (insert) and mounted on or over the drop center 2 of the rim 1 within the tire interior and extending around the entire periphery (circumference) of the rim 1, tube and filling material are "adjusted with respect to each other in such a way that by way of the centrifugal force during the rolling of the tire, the tube 5 remains seated in the rim 1" (tube is "coupled to" filling material, rubber tube necessarily has some value of "centrifugal force resisting tensile strength, at least in the circumferential direction of the tire" and the claims do not require any particular value of such tensile strength). It should be noted that the instant claim term "perforated foil" does not distinguish over the EP '306 perforated rubber bicycle tube or tire inner tube because 1) the original disclosure provides no special definition for the term which would require a thickness less than that of a rubber bicycle tube or tire inner tube (which is essentially a toroidal rubber balloon), and 2) contrary to appellants' arguments (pp. 21 and 29 of the brief), the dictionary definition of the term "foil" as "a thin flexible sheet of metal" in Webster's II New College Dictionary cannot control the interpretation of the claim term "perforated foil" because requiring the foil to be metal would exclude appellants' own preferred embodiment of foil made of "synthetic material" (specification

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paragraph 0061). As to claim 7, the distribution of the perforations can be regular (p. 10 last line) and one of ordinary skill in the art would have understood the rubber tube material itself to be isotropic (same material properties in all directions) unless otherwise specified, resulting in an isotropic perforated rubber tube.

The above prior art rejection of claims 6 and 7 is considered by the examiner to sufficiently address the unpatentability of these claims, therefore the indefiniteness rejection of claims 6 and 7 based on the “foil” language has not been maintained by the examiner. Also, appellants have clarified that the claim 6 language requiring the perforated foil to be “oriented in a circumferential direction” in fact means only that the perforated foil *extends* in the circumferential direction and not that the foil material itself is somehow oriented, therefore the indefiniteness and new matter rejections of claims 6 and 7 based on the “oriented” language have not been maintained by the examiner.

II. The added subject matter filed in this continuing application which is not supported by the original disclosure in the parent application is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new language in paragraphs 0029, 0031, and 0033-0035 is not supported by the original disclosure (parent application as originally filed).

Appellants argue that the added subject matter corresponds to the claims filed in this application, but because this application is a continuation of parent application 08/955,920 the original disclosure is the parent application as originally filed and not this application as originally filed (MPEP 608.04(b): the changes to the parent application disclosure as originally filed constitute

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a preliminary amendment which does not form part of the original disclosure in this continuation application). Appellants' other arguments are addressed in the new matter rejection of claims 1-3 and 8-21 below.

III. Claims 1-3 and 8-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a new matter rejection: there is neither literal nor inherent support in the parent application original disclosure (which is understood by the examiner to include the parent application original specification, claims, and drawings, contrary to appellants' arguments) for the instant claim 1 language.

A. There is no literal support in the parent application original disclosure for the instant claim 1 language.

Appellants have literal support in the parent application for the following:

- 1) the generic language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11);
- 2) the alternative generic language describing the sound-absorbing insert as open-cell foamed material whose pores are oriented predominately in the circumferential direction to provide the insert with tensile strength in the circumferential direction (specification

paragraphs 0012-0014, 0024, and 0070 and parent specification p. 3 lines 13-27, p. 5 lines 24-30, and p. 10 line 27 - p. 11 line 9)

3) the subgeneric language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) including wrapping the support element over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section (specification paragraph 0015 and parent specification p. 3 line 29 - p. 4 line 1);

4) the alternative subgeneric language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) including [layers of] the support element placed at discrete radial distances from each other in the sound-absorbing insert (specification paragraph 0016 and parent specification p. 4 lines 4-9) such as by forming the insert from a ring-shaped strip of sound-absorbing material that is looped around the rim several times, the support element attached to at least the outer side of the strip such that each layer of the strip also contains a support element layer (specification paragraphs 0020-0021 and 0064-0067 and parent specification p. 4 line 29 - p. 5 line 6 and p. 9 line 25 - p. 10 line 13);

5) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *fibers that are distributed preferably uniformly in the sound-absorbing insert and oriented predominately in the circumferential direction of the tire* (specification paragraphs 0016, 0025-

0026, and 0071-0072 and parent specification p. 4 lines 9-12, p. 6 lines 1-13, and p. 11 lines 11-30) which therefore is covered by neither instance of subgeneric language (the fibers preferably uniformly distributed inside the insert are neither wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section nor placed in layers at discrete radial distances from each other in the sound-absorbing insert);

6) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *a woven mesh* (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7) covered by both instances of subgeneric language (the woven mesh can be either wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section or placed in layers at discrete radial distances from each other in the sound-absorbing insert); and

7) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *a perforated foil* (specification paragraphs 0018, 0061, and 0065 and parent specification p. 4 lines 20-23, p. 9 lines 9-14, and p. 10 lines 1-7) covered by both instances of subgeneric language (the perforated foil can be either wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a

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portion of the insert cross-section or placed in layers at discrete radial distances from each other in the sound-absorbing insert).

By contrast, the subgenus language of instant claim 1 requires the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction” which clearly does not have literal support in the parent application original disclosure: the presence of dependent claims 4 and 5 directed to the woven mesh support element makes clear that the instant claim 1 language encompasses something more than just the originally disclosed woven mesh (otherwise these claims would not further limit claim 1). Note that appellants’ arguments mischaracterize the examiner’s position as requiring literal support for the claim 1 subject matter, which is clearly not the examiner’s position in view of part B below.

B. There is no inherent support in the parent application original disclosure for the instant claim 1 language.

Appellants argue that the subgenus language of instant claim 1 requiring the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction” is inherently disclosed because the general importance of tensile strength in the circumferential direction of the insert is disclosed and the woven mesh species is disclosed, however this is not the case here because:

1) The test for compliance with the written description requirement of 35 U.S.C. 112 first paragraph is not what would have been *obvious* to one of ordinary skill in the art but what is expressly or inherently *disclosed*. See, e.g., *Lockwood v. American Airlines Inc.*, 41 USPQ2d 1961, 1966 (CAFC 1997) (“Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed. ... The

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question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. ... A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.”) and *In re Barker and Pebl*, 194 USPQ 470, 474 (CCPA 1977) quoting *In re Winkhaus, Tusche, and Kampf*, 188 USPQ 129, 131 (“That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellant’s invention.”).

2) The parent application original disclosure does not include a *representative number* of specific support element embodiments to adequately describe the new subgenus language of instant claim 1 requiring the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction”. See, e.g., *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1406.

a) The presence of dependent claims 4 and 5 directed to the woven mesh support element makes clear that the instant claim 1 language encompasses something more than just the originally disclosed woven mesh (otherwise these claims would not further limit claim 1).

b) The only one of the originally disclosed support element examples noted above containing any fibers *in a distinct layer* (as opposed to the short fibers uniformly distributed in the insert material itself, specification paragraphs 0016, 0025-0026, and 0071-0072 and parent specification p. 4 lines 9-12, p. 6 lines 1-13, and p. 11 lines 11-30) is the specific woven mesh support element (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7).

c) The originally disclosed generic language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) in combination with the originally disclosed embodiment wherein the support element is in the form of a woven mesh (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7) does not adequately describe the particular subgenus of support elements “comprising at least one layer of fibers oriented in a circumferential direction” “coupled to” the sound-absorbing insert for purposes of compliance with the written description requirement of 35 U.S.C. 112 first paragraph because there is no indication in the parent application original disclosure that applicants considered the subgenus structure to be the only characteristic of the woven mesh important in achieving circumferential tensile strength (for example, it may very well be at least as important that the woven mesh has fibers extending around the *entire circumference* of the insert and/or transverse fibers linking together the circumferential fibers in order to provide the requisite degree of tensile strength to the insert) and there are no other originally disclosed support element embodiments sharing the subgenus characteristics that would suggest that applicants were in possession of that subgenus at the time of filing of the parent application. See, e.g., *In re Smith*, 173 USPQ 679, 683-684 (CCPA 1972) (generic disclosure plus species with at least 12 carbon atoms did not support subgenus of at least 8 carbon atoms) and *In re Lukeach, Olson, and Spurlin*, 169 USPQ 795, 797 (generic disclosure of small molecular weight ratio plus species of molecular weight ratio 2.6 did not support molecular weight ratio 2.0-3.0). This is especially true in view of applicants’ statement that “A series of possibilities exist for concrete embodiments of the support elements”

(specification paragraph 0017 and parent specification p. 4 line 14), the specific nonfibrous perforated foil support element embodiment (specification paragraphs 0018, 0061, and 0065 and parent specification p. 4 lines 20-23, p. 9 lines 9-14, and p. 10 lines 1-7), and the virtually unlimited and *unpredictable* number of possible support element materials and constructions generically having tensile strength in at least the circumferential direction, including material whose microstructure has been chemically or physically modified to produce the requisite degree of tensile strength in the circumferential direction.

Appellants have clarified that the claim 1 language does *not* include the species wherein the support element is provided as “fibers that are distributed uniformly in the sound-absorbing insert and oriented predominantly in the circumferential direction of the tire” rather than the woven mesh, therefore the indefiniteness rejection of the claim 1 language based on appellants’ previous arguments that the claim 1 language encompassed that species have not been maintained by the examiner. Appellants also do not argue the examiner’s position that the specification paragraph 0067 requires the “at least one side” of the wrapped strip of sound-absorbing material in claim 10 to be *at least the radially outer side*, therefore the indefiniteness rejection of claim 10 based on the “at least one side” language has not been maintained by the examiner.

(11) Response to Argument

Appellants’ arguments have been addressed in the Grounds of Rejection section above. It should first be noted that appellants apparently concede that there is no literal support in the parent application for the subgenus language of instant claim 1 requiring the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction” (and for the corresponding language added to the specification) because appellants argue only that the subgenus language is inherently disclosed by the

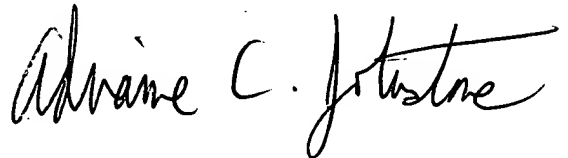
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woven mesh species alone (arguments equate the woven mesh with the subgenus language "at least one layer of fibers oriented in a circumferential direction" and equate the attachment of the woven mesh to the insert with the subgenus language of the insert being "coupled to" the "at least one layer of fibers oriented in a circumferential direction"), which argument is not persuasive for the reasons noted above in the rejection. Also note that the examiner properly considered the original disclosure of the parent application to include the parent application original specification, claims, and drawings, contrary to appellants' arguments. Note further that appellants' arguments mischaracterize the examiner's position as requiring literal support for the claim 1 subject matter (and for the corresponding language added to the specification), which is clearly not the examiner's position in view of the discussion in the above rejection of lack of both literal and inherent support for the claimed subject matter in the original disclosure of the parent application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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April 7, 2005

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